

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: BUKSHPAN4

In re Application of:)	Conf. No.: 1608
)	
Shmuel BUKSHPAN)	Art Unit: 1765
)	
Appln. No.: 10/561,244)	Examiner:
)	
Filed: December 19, 2005)	Washington, D.C.
)	
For: METHODS AND APPARATUS FOR)	July 10, 2006
RAPID CRYSTALLIZATION OF)	
BIOMOLECULES)	

PETITION TO MAKE SPECIAL UNDER 37 C.F.R. §1.102(d)

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, Mail Stop Petitions
401 Dulany Street
Alexandria, VA 22314

Sir:

Applicant hereby requests that the present application be granted special status so as to receive accelerated examination in accordance with 37 C.F.R. §1.102(d). The requirements set forth in MPEP §708.02.VIII are all included herewith as follows.

MPEP §708.02.VIII provides that a new application may be granted special status provided that applicant complies with each of five specified items. These items set forth in the MPEP under paragraphs (A)-(E) will be discussed in turn below.

(A) The present paper is a petition to make special. The fee set forth in 37 C.F.R. §1.17(h) is attached hereto.

(B) All of the claims must be directed to a single invention or if the Office determines that all of the claims presented are not obviously directed to a single invention, applicant agrees to make an election without traverse as a prerequisite to the grant of special status.

It is believed that all 87 of the present claims are directed to single invention as is evidenced by the fact that all were searched and examined during the international phase of the present application. However, if the Office determines that all the claims presented are not obviously directed to a single invention, applicant hereby agrees to make an election without traverse.

(C) A statement must be submitted that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement if the claims in the corresponding foreign application are of the same or similar scope to the claims in the U.S. application for which special status is requested.

Applicant hereby states that a search was made by the United States International Searching Authority by

Examiner Felisa Hiteshew. A copy of the International Search Report is attached hereto. It indicates that U.S. classes 117/68; 436/180, 174, 166; and 530/395 were searched. Furthermore, it indicates that STN (hcaplus, inspec, japio, uspatall) were searched.

(D) One copy each of the references deemed most closely related to the subject matter encompassed by the claims must be submitted. The only patent listed in the International Search Report is a U.S. patent, and it is referred to on an Information Disclosure Statement submitted herewith. In view of the fact that U.S. patents are readily available to examiners, it is believed that this is equivalent to submitting a copy of the reference. The references cited in the Background section of the present application are also present in the Information Disclosure Statement.

(E) A detailed discussion of the references must be submitted, which discussion points out, with the particularity required by 37 C.F.R. §1.11(b) and (c), how the claimed subject matter is patentable over the references.

Attached hereto is a copy of the International Preliminary Report on Patentability which shows that all of the claims were considered to be novel and to possess an inventive step over the reference found in the search and all were found to possess industrial applicability. The Written

Opinion of the International Searching Authority was signed by Benjamin Utech of the U.S. Patent and Trademark Office. This should be sufficient to establish that the claimed subject matter is patentable over the reference cited in the International Search Report. As stated in the last paragraph on page 2 of the present specification, the present invention is based in part on the unexpected discovery that concentrating a dilute protein solution by utilizing any IEF procedure generates a protein solution that facilitates rapid crystallization of the proteins within the solution. This discovery and insight is not disclosed by any of the references mentioned in the Background section of the present specification. Accordingly, the claimed subject matter is patentable over the references.

Accordingly, granting of special status to the present application and issuance of a first official action on the merits as soon as possible is earnestly solicited.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant(s)

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INTERNATIONAL SEARCH REPORT

International application No.

PCT/IL04/00794

A. CLASSIFICATION OF SUBJECT MATTER

IPC(7) : C30B 29/54; G01N 01/10; C07K 01/00

US CL : 117/68; 436/180, 174, 166; 530/395

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 117/68; 436/180, 174, 166; 530/395

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched
N/A

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)
STN (hcaplus, inspec, japio, uspatall)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A,E	US 6,808,934 B2 (Mutz, et al) 26 October 2004	1-87

☐ Further documents are listed in the continuation of Box C.

☐ See patent family annex.

* Special categories of cited documents:

"A" document defining the general state of the art which is not considered to be of particular relevance

"E" earlier application or patent published on or after the international filing date

"L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)

"O" document referring to an oral disclosure, use, exhibition or other means

"P" document published prior to the international filing date but later than the priority date claimed

"T"

later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention

"X"

document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone

"Y"

document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art

"&"

document member of the same patent family

Date of the actual completion of the international search

05 January 2005 (05.01.2005)

Date of mailing of the international search report

18 FEB 2005

Name and mailing address of the ISA/US

Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Facsimile No. (703)305-3230

Authorized officer

Felisa Hiteshew

Telephone No. (571) 272-1700

From the INTERNATIONAL BUREAU

PCT

NOTIFICATION CONCERNING
TRANSMITTAL OF COPY OF INTERNATIONAL
PRELIMINARY REPORT ON PATENTABILITY
(CHAPTER I OF THE PATENT COOPERATION
TREATY)

(PCT Rule 44bis.1(c))

To:

WEBB, Cynthia
Webb & Associates
P.O. Box 2189
76121 Rehovot
ISRAËL

Date of mailing (*day/month/year*)
16 March 2006 (16.03.2006)

Applicant's or agent's file reference
BUKSHPAN/001 PCT

IMPORTANT NOTICE

International application No.
PCT/IL2004/000794

International filing date (*day/month/year*)
02 September 2004 (02.09.2004)

Priority date (*day/month/year*)
03 September 2003 (03.09.2003)

Applicant

BIOFORMS et al

The International Bureau transmits herewith a copy of the international preliminary report on patentability (Chapter I of the Patent Cooperation Treaty)

The International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland

Authorized officer

Simin Baharlou

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PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY

(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44*bis*)

Applicant's or agent's file reference BUKSHPAN/001 PCT	FOR FURTHER ACTION	See item 4 below
International application No. PCT/IL2004/000794	International filing date (<i>day/month/year</i>) 02 September 2004 (02.09.2004)	Priority date (<i>day/month/year</i>) 03 September 2003 (03.09.2003)
International Patent Classification (8th edition unless older edition indicated) See relevant information in Form PCT/ISA/237		
Applicant BIOFORMS		

1. This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis*.1(a).

2. This REPORT consists of a total of 4 sheets, including this cover sheet.

In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.

3. This report contains indications relating to the following items:

- | | | |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I | Basis of the report |
| <input type="checkbox"/> | Box No. II | Priority |
| <input type="checkbox"/> | Box No. III | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability |
| <input type="checkbox"/> | Box No. IV | Lack of unity of invention |
| <input checked="" type="checkbox"/> | Box No. V | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/> | Box No. VI | Certain documents cited |
| <input type="checkbox"/> | Box No. VII | Certain defects in the international application |
| <input type="checkbox"/> | Box No. VIII | Certain observations on the international application |

4. The International Bureau will communicate this report to designated Offices in accordance with Rules 44*bis*.3(c) and 93*bis*.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44*bis* .2).

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland Facsimile No. +41 22 740 14 35	Date of issuance of this report 06 March 2006 (06.03.2006) Authorized officer <div style="text-align: center; font-weight: bold;">Simin Baharlou</div> Telephone No. +41 22 338 71 30
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PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:
CYNTHIA WEBB
WEBB & ASSOCIATES
P.O. BOX 2189
REHOVOT, ISRAEL 76121

PCT

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

Date of mailing
(day/month/year)

18 FEB 2005

Applicant's or agent's file reference

BUKSHPAN/001 PCT

FOR FURTHER ACTION

See paragraph 2 below

International application No.

International filing date (day/month/year)

Priority date (day/month/year)

PCT/IL04/00794

02 September 2004 (02.09.2004)

03 September 2003 (03.09.2003)

International Patent Classification (IPC) or both national classification and IPC

IPC(7): C30B 29/54; G01N 01/10; C07K 01/00 and US Cl.: 117/68; 436/180, 174, 166; 530/395

Applicant

BIOFORMS

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US

Mail Stop PCT, Attn: ISA/US
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Facsimile No. (703)305-3230

Authorized officer

Benjamin Utech

Telephone No. (703) 308-0661

WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY

International application No.

PCT/IL04/00794

Box No. I Basis of this opinion

1. With regard to the language, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This opinion has been established on the basis of a translation from the original language into the following language _____, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any nucleotide and/or amino acid sequence disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

☐ a sequence listing

☐ table(s) related to the sequence listing

b. format of material

☐ in written format

☐ in computer readable form

c. time of filing/furnishing

☐ contained in international application as filed.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

**WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY**

International application No.
PCT/IL04/00794

Box No. V Reasoned statement under Rule 43 *bis*.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims <u>1-87</u>	YES
	Claims <u>NONE</u>	NO
Inventive step (IS)	Claims <u>1-87</u>	YES
	Claims <u>NONE</u>	NO
Industrial applicability (IA)	Claims <u>1-87</u>	YES
	Claims <u>NONE</u>	NO

2. Citations and explanations:

Claims 1-87 meet the criteria for PCT Article 33(2) and (3) because the references fail to disclose or suggest the claimed subject matter.

Claims 1-87 meet the criteria for PCT Article 33(4) thus having industrial applicability because the subject matter can be made or used in the industry.